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**OFFICE OF PETITIONS**

In re Application of  
Ehwald, et al.  
Application No. 09/865,338 :  
Filed: 28 May, 2001 :  
Attorney Docket No. 010462 :

ON PETITION

This is a decision on the petition filed on 6 February, 2006, to revive the above-identified application under 37 C.F.R. §1.137(a)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

**NOTES:**

(1) Any petition (and fee) for reconsideration of this decision under 37 C.F.R. §1.137(a) (as to unavoidable delay) or an alternative request for relief under 37 C.F.R. §1.137(b)<sup>1</sup> (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R.

<sup>1</sup> Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). A grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.  
(2) the petition fee as set forth in 37 C.F.R. §1.17(m);  
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and  
(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

§1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(a)"; and/or "Petition under 37 C.F.R. §1.137(b)";

- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) In matters such as this in which Petitioner observes that the Office has not responded to Petitioner's filing(s), Petitioner may find it of particular value and import (to demonstrate or otherwise evidence at a later date Petitioner's diligence in attention to such matters) to calendar a Status Inquiry at six- (6-) month intervals.

#### BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 25 September, 2002, with a reply due absent an extension of time on or before 26 December, 2002;
- as a result, the application was deemed abandoned after midnight 26 December, 2002;
- the Office mailed the Notice of Abandonment on 6 May, 2003;
- other than a single financial transaction in January, 2003, there is no indication that Petitioner took any action regarding this matter until the filing of a Status Inquiry on 12 January, 2006—nearly thirty-seven (37) month after abandonment and thirty-two (32) months after Notice of Abandonment was mailed;
- in the instant petition (with fee authorization), Petitioner simply avers what already is known and provides no documentary evidence in support;
- moreover, there is no explanation from Petition for the lack of inquiries in the three- (3-) year period described above.

Petitioner is reminded to consult the MPEP Chapter 700, specifically MPEP §711.03(c) for a discussion of the requirements as to petitions to revive under 37 C.F.R. §1.137(a).

The extended period of inaction in this matter and the materials or lack thereof in the instant filing suggest that Petitioner is unlikely to satisfy the showing requirement of 37 C.F.R. §1.137(a), and Petitioner's only relief likely is a petition under 37 C.F.R. §1.137(b).

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup>

And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>)

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

As to the Allegation  
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

With regard to the petition to revive under 37 C.F.R. §1.137(a), Petitioner has failed to satisfy the "showing" requirements, with documentary support (docket reports, file jacket cover notations, notes-to-file, etc.) under the regulation.

ALTERNATIVE VENUE

If Petitioner is unable to make a showing of unavoidable delay, Petitioner's only alternative to irretrievable abandonment is to file a petition under 37 C.F.R. §1.137(b) (state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional").

Thus, Petitioner may wish to supplement the petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

**Petitioner once again is reminded that in matters such as this in which Petitioner observes that the Office has not responded to Petitioner's filing(s), Petitioner may find it of particular value and import (to demonstrate or otherwise evidence at a later date Petitioner's diligence in attention to such matters) to calendar a Status Inquiry at six- (6-) month intervals.**

CONCLUSION

The instant petition under 37 C.F.R. §1.137(a) is dismissed.

Further correspondence with respect to this matter should be addressed as follows.<sup>8</sup>

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<sup>8</sup> On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/ola/preognitice/cfax062005.pdf>.)

By mail:      Commissioner for Patents<sup>9</sup>  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX:      IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand:      Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>9</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).